

**REMARKS**

Favorable reconsideration of this application is respectfully requested in view of the amendments above and the following remarks. By virtue of the amendments above, Claim 53 has been canceled and Claims 8, 12, 25, and 38 have been amended. Therefore, Claims 2-4, 8, 9, 12, 25, 38, 51, 52, and 54-68 are currently pending in the present application, of which, Claims 8, 12, 25, and 38 are independent.

No new matter has been introduced by way of the claim amendments and entry thereof is therefore respectfully requested.

**Information Disclosure Statement and Drawings**

The Applicants note with appreciation the indication that the references cited in the Information Disclosure Statement filed on October 31, 2003 have been considered and that the Drawings submitted on October 31, 2003 are accepted.

**Allowable Subject Matter**

The indication that Claims 52, 53, 55, 59, 60, 64, and 65 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form is also noted with appreciation. Claim 8 has been amended to include all of the features of allowable Claim 53 and is thus allowable over the cited documents of record. In addition, Claims 2-4, 9, 51, 52, and 54 are also allowable over the cited documents of record at least by virtue of their dependencies upon allowable Claim 8.

However, Claims 55, 59, 60, 64, and 65 have not been incorporated into independent claims because it is respectfully submitted that the current independent claims upon which they depend are allowable over the cited documents of record. However, Applicants respectfully reserve the right to amend these claims at a later time.

*Claim Rejection Under 35 U.S.C. §102*

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

Claims 12, 25, 38, 56-58, 61-63, and 66-68 have been rejected under 35 U.S.C. §102(b) as allegedly being anticipated by the disclosure contained in U.S. Patent No. 5,718,628 to Nakazato et al. This rejection is respectfully traversed because Nakazato et al. fails to disclose all of the elements contained in Claims 12, 25, and 38 and the claims that depend therefrom.

Initially, Nakazato et al. fails to disclose a data center having a lowered ceiling, with a plurality of returns positioned at various locations of the lowered ceiling, as set forth in Claims 12, 25, and 38 of the present invention. Instead, Nakazato et al. discloses that each of the equipment 7 include air outlets 7b, through which air is exhausted from the equipment 7. A fan 7f is positioned beneath each of the air outlets 7b to draw air through each of the equipment 7. The exhausted air is either re-circulated back into the equipment 7 or is drawn into an indoor unit 11 of an air conditioner, as seen in Figure 1 of Nakazato et al.

Nakazato et al. asserts that the re-circulation of the air exhausted from the equipment 7 into the equipment 7 is beneficial for a number of reasons. In one regard, Nakazato et al. argues that the circulation of the exhausted air into the air stream flowing from the indoor unit 11 reduces the air-blowing capacity of the indoor unit 11, thereby “leading to reduction of the facility cost.” Nakazato et al. also argues that “[i]t is also possible to suppress the power consumption of the indoor fan 13, leading to a low operating cost” due to the air re-circulation. (Column 5, lines 2-8). Nakazato et al. further asserts that “the temperatures of the air streams released from the plural equipments 7 are made uniform, leading to a satisfactory temperature distribution within the room space 1.” (Column 5, lines 12-15). By “satisfactory temperature distribution,” Nakazato et al. is referring to a “comfortable living environment” in the room space 1. (Column 5, lines 26-27).

Nakazato et al., therefore, teaches away from the use of a lowered ceiling having a plurality of returns because Nakazato et al. advocates for the air exhausted from the equipment 7 to be re-circulated into the equipment 7. In this regard, it would also not have been obvious to modify Nakazato et al. to include a lowered ceiling with a plurality of returns configured to remove air from various locations of room space 1.

Nakazato et al. also fails to disclose that removal of cooling fluid or air from the racks are varied in response to sensed rack temperatures being outside of a predetermined temperature range as set forth in Claims 12, 25, and 38 of the present invention. Instead, Nakazato et al. discloses that the rate at which air is exhausted from the equipment 7 is constant and that the **only** change in airflow delivery is performed through operation of an air volume rate control unit 20. As recited in column 4, lines 20-23, Nakazato et al. states that “[t]he controller 40 serves to control the operations of the motors 17M, 16M and 13M in accordance with instruction of the operating unit 41 to **start and stop** operating the system shown in FIG. 1.” (emphasis added). Nakazato et al., therefore, does not disclose that

operations of the air conditioner components, including the indoor fan 13, are varied in response to sensed temperatures being outside of a predetermined temperature range. Consequently, the airflow returning into the indoor unit 11 is also not varied in response to sensed temperatures being outside of a predetermined temperature range.

In addition, Nakazato et al. fails to disclose that operations of the equipment fan 7f is varied in response to sensed temperatures being outside of a predetermined temperature range. Instead, as shown in Figure 3 and its associated description, the only component controlled based upon sensed temperatures is the air volume control unit 20 (step 105). With regard to the passage contained in Column 5, lines 58-63, Nakazato et al. is referring to step 105 wherein the temperature of the airflow delivered into the equipment is controlled through control the control unit 105. Therefore, Nakazato et al. fails to disclose a plurality of returns configured to remove cooling fluid, in which, the removal of the cooling fluid is varied in response to sensed temperatures being outside of a predetermined temperature range.

It is thus respectfully submitted that Nakazato et al. fails to disclose each and every element contained in Claims 12, 25, and 38 of the present invention. Claims 12, 25, and 38, therefore, cannot be anticipated by and are allowable over the disclosure contained Nakazato et al. Accordingly, the Examiner is respectfully requested to withdraw the rejection of Claims 12, 25, and 38 as being anticipated by Nakazato et al.

Claims 56-58, 61-63, and 66-68 depend from respective ones of Claims 12, 25, and 38 and are also allowable over Nakazato et al. at least by virtue of their dependencies. These claims are also allowable over the disclosure contained in Nakazato et al. for additional reasons. For instance, with respect to Claims 57, 62, and 67 of the present invention, Nakazato et al. fails to disclose that a plurality of returns are substantially independently controlled to thereby substantially independently vary removal of the cooling from the racks through the plurality of returns.

*Claim Rejection Under 35 U.S.C. §103*

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

The Official Action sets forth a rejection of Claims 2-4, 8, 9, 51, and 54 under 35 U.S.C. §103(a) as allegedly being unpatentable over the disclosure contained in Spinazzola et al. in view of Nakazato et al. Initially, the Official Action fails to distinguish which of the cited Spinazzola et al. documents the alleged rejection refers, because the Form PTO 1449 submitted on October 31, 2003 lists three such documents. Therefore, it is unclear as to which of these documents the Official Action is basing the alleged rejection of Claims 2-4, 8, 9, 51, and 54. The Examiner is therefore respectfully requested to indicate which of these Spinazzola et al. documents is relied upon in this alleged rejection.

Regardless of which Spinazzola et al. document the Official Action refers, the alleged rejection of Claims 2-4, 8, 9, 51, and 54 is respectfully traversed because Spinazzola et al. and Nakazato et al., considered singly or in combination do not render independent Claim 8 unpatentable. As noted above, independent Claim 8 has been amended to include all of the features of allowable claim 53. For at least this reason, the rejection of Claim 8 based upon

the combined disclosures of Spinazzola et al. and Nakazato et al. is now considered moot.

Accordingly, the Examiner is respectfully requested to withdraw the rejection of Claim 8 and its depending claims and to allow these claims.

*Conclusion*

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

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By

  
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